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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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26986	7590	03/15/2005	EXAMINER	
MORRISS O'BRYANT COMPAGNI, P.C. 136 SOUTH MAIN STREET SUITE 700 SALT LAKE CITY, UT 84101			TRIEU, THAI BA	
			ART UNIT	PAPER NUMBER
			3748	
DATE MAILED: 03/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No.	Applicant(s)	
	10/795,805	SQUIRES, RICHARD K.	
	Examiner	Art Unit	
	Thai-Ba Trieu	3748	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 18 January 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 38-74 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 38-74 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/18/2005.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

This Office Action is in response to the Amendment filed on January 18, 2005. Applicant's cooperation in correcting the informalities in the specification is appreciated. Claims 1-37 were cancelled; and Claims 38-74 were added.

Claim Objections

Claims 47-48 and 57 are objected to because of the following informalities:

1. Claims 47 and 48 should be separately rewritten.
2. In claim 57, Line 2, "... **vehicle of claim 12**" should be replaced by -- **vehicle of claim 53** --, since claim 12 has been cancelled by the amendment filed on January 18, 2005.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 38 and its dependent claims 39-52; claim 53 and its dependent claims 54-64; and claim 65 and its dependent claims 66-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically,

1. In claims 38, 53, and 65, the recitation of "**remotely mounting the turbocharger away from an engine compartment of a vehicle**" renders the claim

indefinite, since it is not clear that how far away the turbocharger is remotely mounted from the engine compartment, in which location in the vehicle the turbocharger is remotely mounted such as at the front wheel, the rear wheel, in the passenger compartment, the roof of the vehicle, or at any location on the under-floor/or under-body of the vehicle, or the turbocharger having a mounting hardware and being mounted on a shelf or a table which is away from an engine compartment of a vehicle. Applicant is required to identify the location in the vehicle where the turbocharger can be remotely mounted.

2. In claim 43, the recitation of "***hardware for mounting the turbocharger proximate the location of the vehicle's existing muffler***" renders the claim indefinite, since it is not clear that how proximate to the muffler such as 1 inch, 2 inches, 10 cm, or 10 mm, the hardware for mounting the turbocharger is mounted. Applicant is required to definite the proximate distance to the muffler where the mounting hardware can be mounted.

3. In claim 46 the recitation of "***duct for coupling said air filter to the turbocharger at a location away from an engine compartment of the vehicle***" renders the claim indefinite, since it is not clear that how far away from the engine compartment the duct is located, in which location in the vehicle the duct is positioned such as at the front wheel, the rear wheel, the fender well, in the passenger compartment, the roof of the vehicle, or at any location on the under-floor/or under-body

of the vehicle. Applicant is required to identify the location in the vehicle where the duct is positioned.

4. In claim 51, the recitation of "**said oil pump being remotely mounted away from the engine compartment of the vehicle**" renders the claim indefinite, since it is not clear that which location in the vehicle is defined to be away from the engine compartment where the oil pump is remotely mounted. Applicant is required to identify the location in the vehicle where the oil pump is mounted on.

5. In claim 54, the recitation of "**mounting the turbocharger proximate the location of the vehicle's existing muffler**" renders the claim indefinite, since it is not clear that how proximate to the muffler such as 1 inch, 2 inches, 10 cm, or 10 mm, the hardware for mounting the turbocharger is mounted. Applicant is required to definite the proximate distance to the muffler where the mounting hardware can be mounted.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claim 38 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,745,568 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the patent "anticipates" application claims 38-41. Accordingly, application claim 38 is not patentably distinct from patent claim 1.

Patent claim 1 requires the following elements:

- a turbocharger;
- an oiling system;
- an oil pump;
- a pressure driven check valve; and
- a mounting hardware.

While in the instant application, claims 38 requires elements:

- a turbocharger;
- an oiling system; and
- a mounting hardware.

Thus it is apparent that the more specific patent claims 1 encompasses application claim 38. Following the rationale in In re Goodman cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal

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disclaimer. Note that since Application claim **38** is anticipated by Patent claim **1** and since anticipation is the epitome of obviousness, then Application claim **38** is obvious over Patent claim **1**.

2. Claim **53** is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim **12** of U.S. Patent No. **6,745,568 B1**. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim **12** of the patent “anticipate” application claim **53**. Accordingly, application claim **53** *is* not patentably distinct from patent claim **12**.

Patent claim **12** requires the following elements:

- mounting an exhaust inlet...; and
- coupling an oil pump.

While in the instant application, claim **53** requires elements:

- mounting an exhaust inlet...; and
- coupling an oil pump.

Thus it is apparent that the more specific patent claims **12** encompasses application claim **53**. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since Application claim **53** is anticipated by Patent claim **12** and since anticipation is the epitome of obviousness, then Application claim **53** is obvious over Patent claim **12**.

3. Claim **65** is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims **24 and 26** of U.S. Patent No. **6,745,568 B1**. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims **24 and 26** of the patent "anticipate" application claims **65**. Accordingly, an application claim 65 is not patentably distinct from patent claim **24 and 26**.

Patent claim **24 and 26** require the following elements:

- a turbocharger;
- an oil pump;
- first exhaust plumbing;
- a check valve;
- an oil drain;
- an oil return line;
- first duct for delivering; and
- mounting hardware.

While in the instant application, claim **65** requires elements:

- a turbocharger;
- an oil pump;
- first exhaust plumbing;
- mounting hardware;
- a first oil line ;
- a second oil line.

Thus it is apparent that the more specific patent claims **24 and 26** encompass application claim **65**. Following the rationale in *In re Goodman* cited in the preceding paragraph, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since Application claim **65** is anticipated by Patent claims **24 and 26** and since anticipation is the epitome of obviousness, then Application claim **65** is obvious over Patent claims **24 and 26**.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 38 is rejected under 35 U.S.C. 102(b) as anticipated by Ruf et al. (Patent Number 4,716,735).

Ruf discloses a turbocharger system for an internal combustion engine, comprising:

a turbocharger (2,3);

an oiling system (5, 6, 14, 15) coupled to the turbocharger for supplying oil to the bearings (Not Numbered) of the turbocharger (See Column 2, lines 14-24);
and

mounting hardware (10) for remotely mounting the turbocharger away from on engine compartment of a vehicle (See Figures 1-2).

Note that the recitation of "**for remotely mounting the turbocharger away from on engine compartment of a vehicle**" is considered as the functional language. Ruf discloses all the structural components of a turbocharger system, which are identical to those of the instant invention. Therefore, the Ruf system is capable of performing the same desired function as the instant invention having been claimed in claim 1. Additionally, a turbocharger having a mounting hardware, as taught by Ruf, can be mounted every where in a vehicle except the engine compartment, or can be mounted on a shelf or a table which is away from the engine compartment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 39-42, 44, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruf et al. (Patent Number 4,716,735), in view of Widenhorn (Patent Number 5,499,693).

Regarding claims 39-42 and 44, Ruf discloses the invention as recited above, and further discloses said turbocharger includes an oil inlet (5), an oil outlet (6), an

exhaust inlet (Not Numbered), an exhaust outlet (Not Numbered), on air charge inlet (Not Numbered), and an air charge outlet (Not Numbered) (Clearly seen in Figure 1).

However, Ruf fails to disclose an oil inlet configured for being coupled to a pressure side of said oiling system; an oil pump in fluid communication with said turbocharger; a valve; and said oiling system including the oiling system of the vehicle.

Widenhorn teaches that it is conventional in the art of lubricating bearings of a turbocharger to utilize an oil inlet configured for being coupled to a pressure side of said oiling system (via 3, 10); wherein said oiling system comprises on oil pump (4) in fluid communication with said turbocharger (7); a valve (11) in fluid communication with the oil inlet (10 to 11 to 20, and then to 21) of the turbocharger to prevent oil from flowing into the turbocharger when the pressure on the pressure side of the oiling system drops below a predetermined level; wherein said oiling system includes the oiling system of the vehicle; wherein on outlet of said valve is positioned before said oil inlet of said turbocharger (See Figures 1-2; Column 1, lines 14-25; Column 2, lines 9-18; Column 3, lines 50-67, and Column 3, lines 1-25).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized an oil inlet configured for being coupled to a pressure side of said oiling system; an oil pump in fluid communication with said turbocharger; a valve; and said oiling system including the oiling system of the vehicle, as taught by Widenhorn, to improve the efficiency of the Ruf turbocharger.

Regarding claims 53, and 55-56, the method as claimed would be inherent during the normal use and operation of the modified Ruf device as disclosed in the rejection of claims 38-40 (See Figures 1-2 of Ruf; and Figures 1-2, Column 1, lines 14-25, Column 2, lines 9-18, Column 3, lines 50-67, and Column 3, lines 1-25 of Widenhorn).

Claims 45 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruf et al. (Patent Number 4,716,735), in view of Widenhorn (Patent Number 5,499,693); and further in view of Minami et al. (Patent Number 4,422,295).

The modified Ruf device discloses the invention as recited above; however, fails to disclose an air filter.

Minami teaches that it is conventional in the art of lubricating system for a turbocharger to utilize an air filter (17) coupled to the air charge inlet of the turbocharger (See Figure 1).

It would has been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized an air filter, as taught by Minami, to improve the efficiency of the modified Ruf turbocharger, since the use thereof would have cleaned the air before the air is to be delivered to the turbocharger.

Claims 48, 50, 60, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruf et al. (Patent Number 4,716,735), in view of Pleuss et al. (Patent Number 6,688,103 B2).

Ruf discloses the invention as recited above, and further discloses said a waste gate.

Pleuss teaches that it is conventional in the exhaust gas turbocharged internal combustion engine art, to utilize a wastegate (36) coupled between an exhaust system of the vehicle at a location before the exhaust inlet of the turbocharger and a wastegate control system for regulating boost pressure (See Figure 1, Column 3, lines 19-21).

It would has been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized a wastegate, as taught by Pleuss, to improve the efficiency of the Ruf device, since the use thereof would have controlled/regulated the charge pressure.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ruf et al. (Patent Number 4,716,735), in view of Widenhorn (Patent Number 5,499,693).

The modified Ruf device discloses the invention as recited above; however, fails to disclose said oil pump being remotely mounted away from the engine compartment of the vehicle.

The recitation of "said oil pump being remotely mounted away from the engine compartment of the vehicle" is considered as a product by process claim, which is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicants to overcome forward with evidence establishing a obvious difference between the two. See *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983).

Claims 52 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruf et al. (Patent Number 4,716,735), in view of Widenhorn (Patent Number 5,499,693); and further in view of Werner (Patent Number 5,323,612).

The modified Ruf device discloses the invention as recited above; however, fails to disclose a pump controller.

Werner teaches that it is conventional in the turbocharger art, to utilize a pump controller (20) for varying the speed of the pump (21) according to engine speed (See Figures 1 and 4, Column 3, lines 66-68, and Column 4, lines 1-5).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized a pump controller, as taught by Werner, to improve efficiency, in the modified Ruf device.

Claims 65-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minami et al. (Patent Number 4,422,295), in view of Ruf (Patent Number 4,716,735).

Minami discloses a turbocharger installation kit for combustion engine, comprising:

- a turbocharger (12) (See Figure 1);
- an oil pump (37) for coupling to the turbocharger to assist in the flow of oil through the turbocharger (See Figure 1);
- first exhaust plumbing (via 25, 26) configured for coupling said turbocharger to a flow of exhaust from an engine of a vehicle (See Figure 1);

first oil line configured for coupling between on oiling system of the vehicle and the turbocharger(See Figure 1); and

a second oil line (via 38, 45) for coupling between the oil pump and the oiling system of the vehicle (See Figure 1);

a first duct (22, 23) for delivering air from the turbocharger to a throttle body of the engine (See Figure 1).

However, Minami fails to disclose mounting hardware.

Ruf teaches that it is conventional in the exhaust gas turbocharger art, to utilize mounting hardware (10) configured for remotely mounting the turbocharger away from an engine of the vehicle.

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized mounting hardware, as taught by Ruf, to reduce the construction cost and to save the space requirement.

Note that the recitation of "***for remotely mounting the turbocharger away from on engine compartment of a vehicle***" is considered as the functional language. The Ruf mounting hardware is capable of performing the same desired function as the instant invention having been claimed in claim 65. Additionally, a turbocharger having a mounting hardware, as taught by Ruf, can be mounted every where in a vehicle except the engine compartment, or can be mounted on a shelf or a table which is away from the engine compartment.

Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over Minami et al. (Patent Number 4,422,295), in view of Ruf (Patent Number 4,716,735); and further in view of Pleuss et al. (Patent Number 6,688,103 B2).

The modified Minami discloses the invention as recited above, and further discloses said a waste gate.

Pleuss teaches that it is conventional in the exhaust gas turbocharged internal combustion engine art, to utilize a wastegate (36) coupled between an exhaust system of the vehicle at a location before the exhaust inlet of the turbocharger and a wastegate control system for regulating boost pressure (See Figure 1, Column 3, lines 19-21).

It would has been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized a wastegate, as taught by Pleuss, to improve the efficiency of the modified Minami device, since the use thereof would have controlled/reguated the charge pressure.

Claim 74 is rejected under 35 U.S.C. 103(a) as being unpatentable over Minami et al. (Patent Number 4,422,295), in view of Ruf (Patent Number 4,716,735); and further in view of Werner (Patent Number 5,323,612).

The modified Minami device discloses the invention as recited above; however, fails to disclose a pump controller.

Werner teaches that it is conventional in the turbocharger art, to utilize a pump controller (20) for varying the speed of the pump (21) according to engine speed (See Figures 1 and 4, Column 3, lines 66-68, and Column 4, lines 1-5).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized a pump controller, as taught by Werner, to improve efficiency, in the modified Minami device.

Allowable Subject Matter

Claims 43, 46-47, 49, 54, 58-59, 61-62, 67-72 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Response to Arguments

Applicant's arguments with respect to claims **38-72** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai-Ba Trieu whose telephone number is (571) 272-4867. The examiner can normally be reached on Monday - Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on (571) 272-4859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thai-Ba Trieu
Primary Examiner
Art Unit 3748

TTB
March 08, 2005